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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/058,052

01/29/2002

Lawrence Wilcock

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12/24/2008

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EXAMINER

NUNEZ, JORDANY

ART UNIT

PAPER NUMBER

2175

NOTIFICATION DATE

DELIVERY MODE

12/24/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE WILCOCK, ALISTAIR NEIL COLES,
and ROGER CECIL FERRY TUCKER

Appeal 2008-1933
Application 10/058,052
Technology Center 2100

Decided: December 22, 2008

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-10, 12-30, 32, 34, and 35. Claims 11, 31, and 33 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm and enter a new ground of rejection under 35 U.S.C. § 112, second paragraph, against claims 12-20 and 34.

The Invention

The disclosed invention relates generally to distinguishing real-world sounds from sounds produced by an audio user interface (Spec. 1). Specifically, an apparatus produces an audio field to serve as an audio interface to services (*id.* at 7). Sound effects permit a user to distinguish one type of service from another via synthesized sounds (*id.* at 32).

Independent claim 1 is illustrative:

1. An audio user-interfacing method in which items are represented in an audio field by corresponding synthesized sound sources from where sounds related to the items appear to emanate,; the method including while the user is able to hear real-world sounds from an environment where the user is located selectively applying, under user control, a distinctive presentation effect to the item-related sounds emanating from at least one synthesised sound source whereby to assist the user in distinguishing the sounds emanating from the at least one sound source from said real-world sounds.

The References

The Examiner relies upon the following references as evidence in support of the rejections:

Courneau	US 5,987,142	Nov. 16, 1999
Singer	US 5,889,843	Mar. 30, 1999

The Rejections

1. The Examiner rejects claims 1-9, 12-19, 21-28, and 30, 32, 34, and 35 as being anticipated under 35 U.S.C. § 102(b) by Courneau.
2. The Examiner rejects claims 10, 20, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Courneau and Singer.

ISSUE #1

Appellants assert that “there is nothing . . . indicating that the user of the Courneau . . . apparatus is able to hear real-world sounds” (Supp. App. Br. 13) because “it appears very likely that stereophonic headphones of the type worn by users of the Courneau et al. device detect environmental sounds and cancel those environmental sounds from the sounds coupled to the stereophonic headphones” (Reply Br. 4).

The Examiner finds that “synthesized sounds, such as sounds heard through stereophonic headphones, are real world sounds” (Ans. 12), “nothing in Courneau would prevent a user from hearing non-synthesized sounds” (*id.*), and “a user would be able to hear sounds not synthesized by headphones if the user’s hearing is good enough and the sounds are loud enough” (*id.* at 15-16).

Did Appellants demonstrate that the Examiner erred in finding that Courneau discloses that a user is able to hear real-world sounds?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Courneau discloses a “spatialization module 1 . . . [that] has the role of making the sound signals (tones, speech, alarms, etc.) heard through the stereophonic headphones in such a way that they are perceived by the listener as if they came from a particular point of space” (col. 2, ll. 14-18).
2. Courneau discloses that “the pilot of an aircraft hears the voice of his copilot as if it is actually coming from behind him” (col. 2, ll. 20-21).
3. Courneau discloses that the “sound spatializing device . . . can be used to increase the intelligibility of the sound sources that it processes” (col. 6, ll. 37-39).
4. Courneau discloses that “the position of the sound source changes as a function of the motions of the pilot’s head” (col. 2, ll. 23-25).
5. Courneau disclose a user perceiving real world sounds, perceiving synthesized sounds from sound sources via a headphone, spatializing sounds from sources such that “the sources . . . appear to be located respectively at different points in space making it easier to discriminate between them” (col. 6, ll. 41-43).
6. The term “effect” includes anything that is “designed to produce a distinctive or desired impression” (*Merriam-Webster’s Collegiate Dictionary* (11th ed., 2005)).

7. Appellants assert that the “distinctive-presentation means . . . corresponds to sound setter 84, Figure 10” (Supp. App. Br. 17). The sound setter 84 is depicted as a rectangular box in the figures of the Specification (Fig. 10) and described in functional terms in the Specification (Spec. 32).
8. Claims 12-20 and 34 are in the form of “means-plus-function” claims (Claims Appendix).

PRINCIPLES OF LAW

Indefiniteness

Lack of any structure in the disclosure that corresponds to a claimed “means” indicates that the claim fails to pass muster under 35 U.S.C. § 112, second paragraph. *See, e.g., Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946, 953 (Fed. Cir. 2007); *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381-82 (Fed. Cir. 1999); *In re Dossel*, 115 F.3d 942, 944-46 (Fed. Cir. 1997).

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue

‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) “In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” (*Id.*) (internal citations omitted).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *Id.* at 1742. In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *Id.* at

1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1739). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1741).

ANALYSIS (ISSUE #1)

We agree with the Examiner that the headphones of Courneau permit a user to hear real world sounds, as claimed, "if the user's hearing is good enough and the sounds are loud enough," (Ans. 15-16). One of ordinary

skill in the art would understand that standard headphones, while providing sound through speakers, do not entirely block external sound. Because Courneau does not disclose that the headphones are specially designed to entirely block out environmental sounds (or “real world sounds”), or that blocking out such sounds is necessary, desirable, or otherwise likely to be implemented in the Courneau disclosure, we find no evidence that the headphones of Courneau have this specialized ability.

Appellants assert that “it appears very likely that stereophonic headphones of the type worn by users of the Courneau et al. device detect environmental sounds and cancel those environmental sounds from the sounds coupled to the stereophonic headphones” because “headphones with noise canceling features worn by pilots and co-pilots of combat aircraft are obviously more sophisticated than those employed for commercial purposes” (Reply Br. 4). However, we find no evidence or disclosure in Courneau that the specifically disclosed headphones have noise canceling features, that a user in the Courneau system utilizing the headphones would be unable to hear environmental or real world sounds, that “more sophisticated” headphones would necessarily be able to completely block out environmental or real world sounds, or that pilots or co-pilots would necessarily employ only headphones that are able to block out environmental sounds entirely. Also, even assuming that noise-cancelling headphones are indeed able to entirely block out environmental sounds, which Appellant has not demonstrated or asserted, and even assuming that

such headphones are “more sophisticated than those employed for commercial purposes” (*id.*), we find no evidence supporting Appellants contention that the headphones in Courneau are, in fact, such headphones.

Appellants argue that “[i]f the pilot of the aircraft were able to hear real world sounds, he would be able to hear the voice of his co-pilot who is sitting directly behind him” (Reply Br. 4). While Courneau discloses that a pilot may utilize headphones to hear a co-pilot’s voice “as if it is actually coming from behind him” (col. 2, ll. 20-21), Courneau does not disclose that the pilot is unable to hear the voice of the co-pilot. For example, the pilot may be able to hear the co-pilot’s voice directly from the co-pilot but may also hear the co-pilot’s voice with increased clarity via the headphones. Indeed, Courneau discloses that the “sound spatializing device . . . can be used to increase the intelligibility of the sound sources that it processes” (col. 6, ll. 37-39). In any event, Courneau does not disclose or even imply that the pilot is unable to hear real-world sounds. As such, we find that the weight of the evidence supports the Examiner’s finding that the user in Courneau is able to hear real-world sounds.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 1-10, 12-30, 32, 34, and 35 with respect to issue #1.

ISSUE #2

Appellants assert that in Courneau, “the hearing characteristics of the subject are not applied as a distinctive presentation effect to item-related sounds emanating from synthesized sound source 24, Figure 3, to assist the subject who is wearing the headphones in distinguishing the sounds emanating from sound source 24 from real-world sounds” (Supp. App. Br. 13). Appellants thus assert that Courneau does not teach a user applying a distinctive presentation effect to an item-related sound emanating from a synthesized sound source.

The Examiner “reads spatializing as the application of the distinctive presentation effect” (Ans. 13).

Did Appellants demonstrate that the Examiner erred in finding that Courneau discloses a user applying a distinctive presentation effect to the item-related sounds emanating from a synthesized sound source?

ANALYSIS (ISSUE #2)

Courneau discloses spatializing sounds as including “making the sound signals . . . in such a way that they are perceived by the listener as if they came from a particular point of space” (col. 2, ll. 15-18). In the absence of an explicit definition of a “distinctive presentation effect” in the Specification, we construe the term broadly but reasonably in this context to include any feature applied to sound that would serve to distinguish the sound to a listener (i.e., presented to the user in a “distinctive” way).

Because “spatializing” sound in Courneau includes positioning the sound at a particular point in space and because the position of the sound in space serves to distinguish the sound to a listener, we agree with the Examiner that spatializing a sound (as in Courneau) includes assigning a “distinctive presentation effect” to the sound.

Appellants argue that “the hearing characteristics of the subject are not applied as a distinctive presentation effect to item-related sounds” (Supp. App. Br. 13). However, the Examiner finds that “spatializing” of sounds, and not “the hearing characteristics of the subject,” is equivalent to a distinctive presentation effect. Therefore, we are unpersuaded by Appellants’ argument.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 1-10, 12-30, 32, 34, and 35 with respect to issue #2.

ISSUE #3

The Examiner finds that “[p]ersonalization of [t]he headphones is done ‘under user control’ because said user controls the personalization of the headphones to obtain the most efficient possible localization of a virtual sound source for each user (column 1, lines 35-52)” (Ans. 13).

Appellants assert that “personalization is associated with the hearing characteristics of the ears of the subject who is wearing the headphones” and

that the “subject wearing the headphones has no control over the hearing characteristics of his ears during testing to determine the subject’s hearing characteristics” (Reply Br. 8).

Did Appellants demonstrate that the Examiner erred in finding that Courneau discloses applying a distinctive presentation effect is under user control?

ANALYSIS (ISSUE #3)

We agree with the Examiner that the operation of the headphones in Courneau is “under user control.” Spatialization of sound in Courneau includes applying a “distinctive presentation effect” to the sound, as set forth above, and Courneau discloses that “the position of the sound source changes as a function of the motions of the pilot’s head” (col. 2, ll. 23-25). Hence, a user, by utilizing head movement, causes adjustment of the spatialization (i.e., distinctive presentation effect) of the sound. Because the user’s head movement is under the user’s control, we find that the application (and adjustment) of the distinctive presentation effect is performed under the user’s control in the Courneau system.

Appellants assert that the user “has no control over the hearing characteristics of his ears during testing” (Reply Br. 8). Even assuming Appellants contention to be true, we do not find Appellants’ assertion to be relevant to whether a user controlling head movement includes an application of a distinctive presentation effect (i.e., spatialization of sound).

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claims 1-10, 12-30, 32, 34, and 35 with respect to issue #3.

ISSUE #4

Appellants assert that Courneau fails to teach "assisting the user in distinguishing the sounds emanating from a sound source from real world sounds" (Supp. App. Br. 13).

The Examiner finds that "any one sound can be distinguished from another, including real-world sounds from synthethized [sic] ones" (Ans. 3).

Did Appellants demonstrate that the Examiner erred in determining that Courneau discloses assisting a user in distinguishing the sounds emanating from a sound source from real world sounds?

ANALYSIS (ISSUE #4)

As set forth above, Courneau disclose a user perceiving real world sounds, perceiving synthesized sounds from sound sources via a headphone, spatializing sounds from sources such that "the sources . . . appear to be located respectively at different points in space making it easier to discriminate between them" (col. 6, ll. 41-43). Also as set forth above, "spatializing" sound in Courneau includes positioning the sound at a particular point in space, which serves to distinguish the sound to a listener.

By permitting a user to distinguish synthesized sounds in the headphone from either other synthesized sounds or real world sounds based on position of the sounds at a particular point in space, we agree with the Examiner that Courneau discloses assisting a user in distinguishing sounds from a sound source from real world sounds.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claims 1-10, 12-30, 32, 34, and 35 with respect to issue #4.

ISSUE #5

Appellants assert that Courneau discloses "convolution filters" and "transfer functions of the ears of the subject who is wearing the headphones" but that the "transfer functions have nothing to do with a sound effect that is a distinctive presentation effect that assists in enabling a user to distinguish sounds emanating from a sound source from real-world sounds" (Supp. App. Br. 14).

The Examiner finds that Courneau's transfer functions are equivalent to sound effects because "transfer functions are subjected [to] a spatial interpolation and then a temporal interpolation and the resultant values are convoluted with the signal to be spatialized (column 4, lines 45-58)" (Ans. 13) and that of one of ordinary skill in the art "would immediately recognize then that a frequency shift is performed in order to spatialize a signal" (*id.*).

Did Appellants demonstrate that the Examiner erred in determining that Courneau discloses a distinctive presentation that is a sound effect that assists a user in distinguishing sounds emanating from a sound source from real-world sounds?

ANALYSIS (ISSUE #5)

In the absence of an explicit definition of the term “effect” in the Specification we adopt a broad but reasonable construction of the term using a plain and ordinary definition that includes anything that is “designed to produce a distinctive or desired impression” (*Merriam-Webster’s Collegiate Dictionary* (11th ed. 2005)). A “sound effect” therefore includes anything designed to produce a distinctive or desired impression that is related to audio-related sensations (i.e., “sound”).

Based on this broad but reasonable use of the term “sound effect,” we agree with the Examiner that Courneau discloses a sound effect. As set forth above, Courneau discloses spatialization of sounds that place sound sources at desired points in space. By placing sound sources at a designated location, the sound emanating from the sound source is characterized and presented with a distinctive location. The distinctive location of the sound that is presented produces “a distinctive or desired impression” on the listener, namely, the impression of the location of the sound source. Moreover, by controlling the location or placement of the sound source, the applied “distinctive presentation effect” (i.e., spatialization or localization of

the sound) would assist the listener or user in distinguishing the sound from other sounds that are at different locations.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claims 3, 4, 14, 15, 23, and 24 with respect to issue #5.

ISSUE #6

Appellants assert that “the office action fails to indicate where Courneau et al discloses all the foregoing structures of the rendering means” recited in claim 12 (Supp. App. Br. 17) and that while “Courneau et al indicates headphones are employed, there is nothing to indicate the headphones enable the user thereof to hear real-world sounds” (*id.*).

Did Appellants demonstrate that the Examiner erred in finding that Courneau discloses a rendering means that enable a user to hear real-world sounds?

ANALYSIS (ISSUE #6)

Appellants equate the audio output devices of the recited “rendering means” of claim 12 with headphones, as disclosed in the Specification (page 9). As set forth above, Courneau discloses headphones. Therefore, we agree with the Examiner that Courneau discloses headphones (i.e., the audio output devices of the “rendering means”).

Appellants argue that Courneau fails “to indicate the headphones enable the user thereof to hear real-world sounds” (Supp. App. Br. 17). We find Appellants argument unpersuasive for reasons set forth above.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 12-20 and 34 with respect to issue #6.

ISSUE #7

Appellants assert that “[t]he distinctive-presentation means limitation under 35 USC 112, paragraph 6 corresponds to sound setter 84, Figure 10” (Supp. App. Br. 17) and that “the office action fails to indicate where Courneau et al discloses all the foregoing structures of the distinctive-presentation means” (*id.* at 17-18) recited in claim 12.

The Examiner “reads applying a distinctive presentation effect to a sound as spatializing a sound source” (Ans. 15).

Did Appellants demonstrate that the Examiner erred in finding that Courneau discloses the distinctive-presentation means recited in claim 12?

ANALYSIS (ISSUE #7)

Appellants assert that the “distinctive-presentation means . . . corresponds to sound setter 84, Figure 10” (Supp. App. Br. 17). The Specification discloses that sound setter 84 is “intended to set a sounding

effect parameter” (Spec. 32), is “operative to set a particular sounding effect parameter” (*id.*), sets “the sound sources of all sub-fields [that] have the related sounding effect parameter . . . to on” (*id.*), and may be multiple with “each associated with a different sound effect” (*id.*). While we do find a rectangular box depicting the sound setter 84 (Spec. Fig. 10), we find no disclosure in the Specification, nor do Appellants indicate a disclosure, of specific structural characteristics of the “sound setter 84.” To the extent that Courneau discloses a component that sets “a sounding effect parameter,” is operative to set a particular sounding effect parameter (i.e., “spatialization”), and can be depicted as a rectangular box, we agree with the Examiner that Courneau discloses a component for applying a distinctive presentation effect to item-related sounds (i.e., a “distinctive-presentation means”).

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 12-20 and 34 with respect to issue #7.

ISSUE #8

Appellants assert that “the office action fails to indicate where Courneau et al discloses all the foregoing structures of the rendering-position determining means” (Supp. App. Br. 16) recited in claim 12.

Did Appellants demonstrate that the Examiner erred in finding that Courneau discloses the rendering-position determining means recited in claim 12?

ANALYSIS (ISSUE #8)

Appellants assert that the “rendering-position determining means includes (1) subsystem 13 comprising memory 14 . . . (page 11, line 30- page 12, line 4; page 14, lines 4-6), (2) real-world location processing block 21 . . . (page 14 lines 4-14), and (3) memory 15 . . . (page 15, lines 25-29)” (Supp. App. Br. 16). While Appellants identify functional descriptions of subsystem 13, processing block 21, and memory 15 in the Specification and while we identify each of subsystem 13, processing block 21, and memory 15 illustrated as rectangular blocks (Spec. Fig. 10), we find no disclosure in the Specification, nor do Appellants indicate a disclosure, of specific structural characteristics of the cited elements. To the extent that Courneau discloses components that render a position of a sound source (i.e., “spatialization” to determine a position of a sound source, as set forth above) and can be depicted as rectangular boxes, we agree with the Examiner that Courneau discloses a component for determining a rendering position at which a sound source is to be synthesized (i.e., a “rendering-position determining means”).

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or

evidence persuasive of error in the Examiner's rejection of claims 12-20 and 34 with respect to issue #8.

NEW GROUND OF REJECTION -- 37 C.F.R. § 41.50(B)

We reject claims 12-20 and 34 under 35 U.S.C. § 112, second paragraph as being indefinite.

Claims 12-20 and 34 are in the form of “means-plus-function” claims to be interpreted under 35 U.S.C. § 112, sixth paragraph.

Independent claim 12 recites “rendering-position determining means for determining . . . an associated rendering position”; “rendering means, including audio output devices, for generating an audio field”; and “distinctive-presentation means for selectively applying . . . a distinctive presentation effect” (Claims Appendix). Appellants assert that:

1. the structure corresponding to the “rendering means includes (1) subsystem 13 comprising memory 14 . . . (page 11, line 30-page 12, line 4; page 14, lines 4-6), (2) real-world location processing block 21 . . . (page 14 lines 4-14, and (3) memory 15 . . . (page 15, lines 25-29)” (Supp. App. Br. 16);

2. the structure corresponding to the rendering means “corresponds or is equivalent to appellants’ (1) memory 15 for storing indications . . . (page 15, lines 25-29), (2) spatialization processor 10 (page 16, lines 1-5) and (3) audio output device 11 in the form of a pair of fixed,

spaced loudspeakers (page 9, lines 29, 30), or a set of headphones (page 9, line 31), or a vehicle sound system (page 11, line 4)” (*id.*); and

3. the structure corresponding to the distinctive-presentation means “corresponds to sound setter 84, Figure 10” (*id.* at 17).

However, we only identify generalized block diagrams and functional characteristics disclosed in the Specification for the cited components. We find no disclosure of structure capable of performing the claimed functions, either in the lines relied upon by Appellant or in the remainder of the disclosure. Claims 12-20 and 34 thus fail to pass muster under 35 U.S.C. § 112, second paragraph.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have failed to demonstrate that the Examiner erred in:

1. finding that Courneau discloses that a user is able to hear real-world sounds (issue #1);
2. finding that Courneau discloses a user applying a distinctive presentation effect to the item-related sounds emanating from a synthesized sound source (issue #2);
3. finding that Courneau discloses applying a distinctive presentation effect is under user control (issue #3);

4. determining that Courneau discloses assisting a user in distinguishing the sounds emanating from a sound source from real world sounds (issue #4);

5. determining that Courneau discloses a distinctive presentation that is a sound effect and that assists a user in distinguishing sounds emanating from a sound source from real-world sounds (issue #5);

6. finding that Courneau discloses a rendering means that enable a user to hear real-world sounds (issue #6);

7. finding that Courneau discloses the distinctive-presentation means recited in claim 12 (issue #7); and

8. finding that Courneau discloses the rendering-position determining means recited in claim 12.

Also, claims 12-20 and 34 are unpatentable under 35 U.S.C. § 112, second paragraph.

DECISION

We affirm the Examiner's decision rejecting claims 1-9, 12-19, 21-28, and 30, 32, 34, and 35 under 35 U.S.C. § 102(b). We affirm the Examiner's decision rejecting 10, 20, and 29 under 35 U.S.C. § 103(a).

In a new ground of rejection, we have rejected claims 12-20 and 34 under 35 U.S.C. § 112, second paragraph as being indefinite.

In addition to affirming the Examiner's rejections of one or more claims, this decision contains a new ground of rejection pursuant to

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37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED
37 C.F.R. § 41.50(b)

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